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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/491,899	01/27/2000	William R. Wells	3735-929	9213

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CHICAGO, IL 60603-5803

EXAMINER

MAHMOUDI, HASSAN

ART UNIT	PAPER NUMBER
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2165

DATE MAILED: 03/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/491,899

Applicant(s)

WELLS ET AL.

Examiner

Tony Mahmoudi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 October 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5, 6, 8-13, 15-17, 19 and 21-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6, 8-13, 15-17, 19 and 21-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
**SAM RIMELL**  
**PRIMARY EXAMINER**

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Remarks*

1. In response to communications filed on 19-October-2004, claims 2-3, 5-6, and 19 are amended, and new claims 27-30 are added per applicant's request. Therefore, claims 1-3, 5-6, 8-13, 15-17, 19, and 21-30 are presently pending in the application, of which, claims 1, 8, 15, and 21-24 are in independent form.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 21-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 21 and 22 recite the limitation "creating a first authenticator." The specification does not describe the "creation of authenticator(s)" in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 23 recites the limitation “electronic transfer” is steps (d) through (f). The specification does not describe the “electronic transfer” in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not clear from either claim 23 or the disclosed specification whether the “electronic transfer” specifies “electronic transfer” of goods (game) from the gaming device to the user, or “electronic transfer” of user information (e.g. authenticators) from the user to the gaming device, or both. The specification does not describe “electronic transfer”, the entity being transferred, and the parties between which the transfer is being completed.

4. Claims 21-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 21 and 22 recite the limitation “creating a first authenticator.” The specification does not describe the “creation of authenticator(s)” in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 23 recites the limitation “electronic transfer” is steps (d) through (f). The specification does not describe the “electronic transfer” in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It is not clear from either claim 23 or the disclosed specification whether the “electronic transfer” specifies “electronic transfer” of goods (game) from the gaming device to the user, or “electronic transfer” of user information (e.g. authenticators) from the user to the gaming device, or both. The specification does not describe “electronic transfer”, the entity being transferred, and the parties between which the transfer is being completed.

*Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 6, 8 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneier et al (U.S. Patent No. 6,099,408) in view of Sehr (U.S. Publication No. 2001/0018660.)

As to claim 1, Schneier et al teaches a gaming apparatus (see Abstract) comprising:

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a portable biometric data storage device (see column 4, lines 47-57, where “biometric data storage device” is read on “optical storage unit”) storing first biometric data for at least a first user (see column 16, lines 14-27);

a gaming terminal (see Abstract, where “gaming terminal” is read on “player terminal”), configured for playing at least a first game (see column 7, lines 46-51);

a reader, coupled to the gaming terminal which receives the first biometric data stored on the biometric data storage device (see column 16, lines 7-10);

a biometric measurement device for measuring biometric data of a user to provide measured biometric data (see figure 3, and see column 6, lines 39-48); and

a comparator for comparing the measured biometric data to the first biometric data (see column 16, lines 10-27) and outputting at least a first notification if there is an absence of match (see column 16, lines 30-33.)

Schneier et al does not teach the biometric data storage device comprising a debit card.

Sehr teaches an electronic ticketing system using multi-service visitor cards (see Abstract), in which he teaches the biometric data storage device comprising a debit card (see Abstract, and see paragraphs 49, 69, and 70.)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Schneier et al to include the biometric data storage device comprising a debit card.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Schneier et al, by the teaching of Sehr, because the biometric data storage device comprising a debit card, would allow the same card to hold the

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user's biometric information as well as his monetary information. The biometric data storage device comprising a debit card would allow the user to access his bank account (linked to the debit card), and/or the funds loaded to the debit card (pre-paid card), to play games and/or place wagers against games, using the same card that also holds his biometric identification data (see Sehr, Abstract.)

As to claims 6 and 13, Schneier et al as modified, teaches wherein:

the biometric measurement device is selected from among a thumb print scanner; a fingerprint scanner; a retina scanner; an iris scanner; an ear scanner; a voice data sensor; a facial scanner; or an infrared scanner (see Schneier et al, column 16, lines 7-13.)

As to claim 8, Schneier et al teaches a gaming method (see Abstract) comprising:

storing first biometric data for at least a first user (see column 16, lines 14-27) in a portable biometric data storage device (see column 4, lines 47-57, where "biometric data storage device" is read on "optical storage unit");

providing a gaming terminal (see Abstract, where "gaming terminal" is read on "player terminal");

coupling a reader to a gaming terminal, configured for playing at least a first game, wherein the reader receives the first biometric data stored on the card (see figure 3, and see column 16, lines 7-10);

measuring biometric data of a the first user to provide measured biometric data (see figure 3, and see column 6, lines 39-48); and

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comparing the measured biometric data to the first biometric data (see column 16, lines 10-27) and outputting at least a first notification if there is an absence of match (see column 16, lines 30-33.)

Schneier et al does not teach biometric data storage device which comprises a card

Sehr teaches an electronic ticketing system using multi-service visitor cards (see Abstract), in which he teaches the biometric data storage device comprising a card (see Abstract, and see paragraphs 49, 69, and 70.)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Schneier et al to include the biometric data storage device comprising a card.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Schneier et al, by the teaching of Sehr, because the biometric data storage device comprising a card, would allow the card to hold the user's biometric information as well as his monetary information. The biometric data storage device comprising a card would allow the user store his biometric information on the card, and to access his bank account (linked to the debit card), and/or the funds loaded to the card (pre-paid card), to play games and/or place wagers against games, using the same card that also holds his biometric identification data (see Sehr, Abstract.)

As to claim 11, Schneier et al as modified teaches wherein:

the card is a debit card (see Sehr, Abstract, and see paragraphs 49, 69, and 70.)

As to claim 12, Schneier et al as modified teaches further comprising:

Storing, on the portable biometric data storage device (see Schneier et al, column 4, lines 47-57, where “biometric data storage device” is read on “optical storage unit”), the current account balance for an account established for the first user (see Sehr, paragraphs 73, 77, and 102.)

7. Claims 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneier et al (U.S. Patent No. 6,099,408) in view of Sehr (U.S. Publication No. 2001/0018660), as applied to claims 1, 6, 8 and 11-13 above, and further in view of Franchi (U.S. Patent No. 5,770,533.)

As to claims 27 and 28, Schneier et al as modified, still does not teach the player's winnings are credited to the current account balance.

Franchi teaches an open architecture casino operating system (see Abstract), in which he teaches the player's winnings are credited to the current account balance (see Abstract; column 3, lines 1-9; column 7, lines 55-62; column 9, lines 22-25; and see column 13, lines 45-50.)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Schneier et al as modified, to include the player's winnings are credited to the current account balance.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Schneier et al as modified, by the teaching of Franchi,

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because including the player's winnings are credited to the current account balance, would provide for a totally cash-free playing, in which the player would not only be able to play without any real cash, coins, or chips, but also could have his winnings credited to his credit/debit/smart card conveniently. This would benefit the player in that he/she does not have to carry cash or tokens from one gaming table/device to another, and at "cash-out", and it would also benefit the gaming vendor/casino in that they would need less personnel to handle cash for players.

8. Claims 2-3, 5, 9-10, 15-17, 19 and 24-26 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneier et al (U.S. Patent No. 6,099,408) in view of Sehr (U.S. Publication No. 2001/0018660), as applied to claims 1, 6, 8 and 11-13 above, and further in view of Thompson (U.S. Patent No. 5,865,470.)

As to claims 2, 9, 16, and 25, Schneier et al as modified, does not teach wherein the card has a thickness of less than about 0.05 inch (although Sehr teaches using standard Credit/Debit cards and it is known in the art that standard Credit/Debit cards have a thickness less than 0.05 inch.)

Thompson teaches a tracking system utilizing microprocessor chip cards (see Abstract), in which he teaches wherein the card has a thickness of less than about 0.05 inch (see column 4, lines 45-49.)

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Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Schneier et al as modified, to include wherein the card has a thickness of less than about 0.05 inch.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Schneier et al as modified, by the teaching of Thompson, because wherein the card has a thickness of less than about 0.05 inch, would enable the card to be used with a standard credit/debit card reader, as taught by Thompson (see column 4, lines 45-49.)

As to claims 3, 10, and 17, Schneier et al as modified still does not teach wherein the card includes a microprocessor.

Sehr further teaches wherein the card includes a microprocessor (see paragraph 35, where “microprocessor” is read on “chip”.)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Schneier et al as modified, to include wherein the card includes a microprocessor.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Schneier et al as modified, with the further teaching of Sehr, because including wherein the card includes a microprocessor, would enable the card to input, store, process, output, and display data relating to events, cardholders and system entities, as well as to services rendered via the card, as taught by Sehr (see paragraph 35.)

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As to claim 5, Schneier et al as modified teaches wherein:

the card further stores the current account balance for an account established for the first user (see Sehr, paragraphs 73, 77, and 102.)

As to claim 15, the applicant is kindly directed to the remarks and discussions made for claims 1 and 5 above.

As to claims 19 and 26, Schneier et al as modified teaches wherein:

the biometric measurement device is selected from among a thumb print scanner; a fingerprint scanner; a retina scanner; an iris scanner; an ear scanner; a voice data sensor; a facial scanner; or an infrared scanner (see Schneier et al, column 16, lines 7-13.)

As to claim 24, the applicant is kindly directed to the remarks and discussions made in claim 1, 8, and 5 above.

Schneier et al as modified, still does not teach debiting an amount from the current account balance on the card as a fee for playing the game, and establishing a new current account balance on the card.

Sehr further teaches debiting an amount from the current account balance on the card as a fee for playing the game (see Abstract, and see paragraphs 49, 62, and 102, where “fee for playing the game” is read on “purchase”.)

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Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Schneier et al as modified, to include debiting an amount from the current account balance on the card as a fee for playing the game.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Schneier et al as modified, by the further teaching of Sehr, because debiting an amount from the current account balance on the card as a fee for playing the game, would keep the “current/updated” remaining balance on the user’s card each time a game is purchased, so that the current balance is compared against the fee of the next game to ensure that proper funds are available before the next game can be authorized for playing, as taught by Sehr (see paragraph 102.)

As to claim 30, Schneier et al as modified teaches in which the card has a thickness of less than about 0.05 inch (see Thompson column 4, lines 45-49), and is a debit card (see Thompson, column 2, line 47 through column 3, line 23, also see Sehr, Abstract, and paragraphs 49 and 56.)

9. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schneier et al (U.S. Patent No. 6,099,408) in view of Sehr (U.S. Publication No. 2001/0018660), and further in view of Thompson (U.S. Patent No. 5,865,470), as applied to claims 2-3, 5, 9-10, 15-17, 19 and 24-26 and 30 above and still further in view of Franchi (U.S. Patent No. 5,770,533.)

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As to claim 29, Schneier et al as modified, teaches the card includes a microprocessor (see Sehr, paragraph 35) and in which the card further stores a current account balance for an account established by the first user (see Sehr, paragraphs 73 and 77.)

Schneier et al as modified, still does not teach in which the user's winnings from the play of the gaming apparatus are credited to the current account balance.

Franchi teaches an open architecture casino operating system (see Abstract), in which he teaches the user's winnings are credited to the current account balance (see Abstract; column 3, lines 1-9; column 7, lines 55-62; column 9, lines 22-25; and see column 13, lines 45-50.)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Schneier et al as modified, to include the user's winnings are credited to the current account balance.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Schneier et al as modified, by the teaching of Franchi, because including the user's winnings are credited to the current account balance, would provide for a totally cash-free playing, in which the player would not only be able to play without any real cash, coins, or chips, but also could have his winnings credited to his credit/debit/smart card conveniently. This would benefit the player in that he/she does not have to carry cash or tokens from one gaming table/device to another, and at "cash-out", and it would also benefit the gaming vendor/casino in that they would need less personnel to handle cash for players.

*Response to Arguments*

10. Applicant's arguments filed on 19-October-2004 with respect to the rejected claims in view of the cited references have been fully considered but they are either not deemed persuasive or they are moot in view of the contents of this Office Action:

In response to the applicant's argument regarding the objection previously made to the amended specification about the "thickness of the card", the argument has been fully considered and is found persuasive. The argument is therefore considered moot in view of the withdrawal of the objection by the examiner.

In response to the applicant's arguments regarding the rejections under 35 U.S.C 112, first and second paragraphs made for claims 21 and 22, the arguments have been fully considered but are not found persuasive. While the examiner appreciates the applicant's explanation of the term "authentication" and its occurrences throughout the disclosed specifications, the examiner is maintaining the above rejections for claims 21-23 because as stated in this and the previous Office Actions, the specification does not describe "the *creation* of authenticator(s)" in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In response to the applicant's arguments regarding the rejections under 35 U.S.C 112, first and second paragraphs made for claim 23, the arguments have been fully considered but are not found persuasive. The examiner does not find the specification's reference to "data

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processing capabilities” to satisfy the recitation of “a player request for an electronic transfer”, as recited in claim 23. The examiner is maintaining these rejections because as mentioned in this and the previous Office Actions, it is not clear from either claim 23 or the disclosed specification whether the “electronic transfer” specifies “electronic transfer” of goods (game) from the gaming device to the user, or “electronic transfer” of user information (e.g. authenticators) from the user to the gaming device, or both. The specification does not describe “electronic transfer”, the entity being transferred, and the parties between which the transfer is being completed.

In response to the applicant’s arguments regarding the newly added claims 27-29 reciting the card being “credited” with the “player’s winnings”, the arguments have been fully considered but are considered moot in view of the new grounds of rejection introduced for these claims.

In response to the applicant’s arguments regarding claims 1 and 8, that “this does not include the concept of storing the biometric information on a debit card, which is carries by the player”, the arguments have been fully considered but are not deemed persuasive because while claim 1 recites “a portable biometric data storage device storing first biometric data for at least a first user; said biometric data storage device comprising a debit card”, “storing the biometric information on a debit card, which is carried by the player” is not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26

USPQ2d 1057 (Fed. Cir. 1993). The examiner does not interpret “storing biometric data on a portable storage device which comprises a debit card” to specifically mean that the “debit card” is the portable biometric storage device” on which the actual “biometric data” is stored.

### *Conclusion*

11. The claims for which interference is being sought (claims 21-23) remain rejected in this Office Action, under 35 U.S.C. § 112, first, and second paragraphs (paragraphs 2-4 of this Office Action.) Accordingly, interference proceedings will not be established at this time. Any future consideration for the interference proceedings would require overcoming the above mentioned rejections

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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13. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Tony Mahmoudi whose telephone number is (571) 272-4078. The examiner can normally be reached on Mondays-Fridays from 08:00 am to 04:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici, can be reached at (571) 272-4083.

tm

February 25, 2005



**SAM RIMELL**  
**PRIMARY EXAMINER**